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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,821	06/18/2002	Robert Benjamin Franks	5897-000010	2406

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EXAMINER	
MEYERS, MATTHEW S	
ART UNIT	PAPER NUMBER
3689	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/030,821	FRANKS ET AL.	
	Examiner	Art Unit	
	MATTHEW S. MEYERS	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's communication on 4/4/02, wherein claims 1-25 are currently pending and claims 26-51 have been withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over www.teas.uspto.gov retrieved from the Internet Archive Wayback Machine of date October 12, 1999, January 10, 2000, and February 8, 2000 (hereinafter referred to TEAS) in view of Lee (US 7,016,851) (hereinafter referred to as Lee) and further in view of Takano et al (US 6,434,580) (hereinafter referred to as Takano).

5. Referring to Claims 1-25:

6. TEAS discloses a method and system for processing transaction data relating to trademarks via at least one computer entity, said comprising:

a. displaying country data (page 5 (country) and page 8 (select country) (the Examiner notes that the Internet Archive retrieved a page from the 5/22/2001 date showing PrintTEAS=Version1.22:8/22/2000. However, the PTO Form 1478 shows a revision date of 9/98);

b. displaying classification data describing a list of goods and services classified into a plurality of different categories (pages 80-106 (page last modified on February 11, 2000 (see page 110));

c. displaying price data relating to at least one transaction price for performing a service in relation to the trademark (page 9 Fees; page 57 are your goods and/or services in more than one class; pages 28-35 last modified on May 26, 2000).

d. inputting individual items of classification data describing items of said list of goods and services classified into a plurality of different categories at the user interface (page 15 (listing of goods and services) and (International Class));

e. inputting data describing a trademark (page 13 Mark information), specifying an applicant (page 12 entity type), financial data of an account of a customer (page 18 Fee information), at the interface (pages 12-19);

f. inputting a user initiated confirmation message confirming the items of data (page 56 Verification and Signature)

g. in response to receiving said input individual items of classification data, trademark data, applicant data, generating a confirmation of order display comprising displayed said input trademark data describing a trademark, said country data describing at least one country, applicant, items of said classification data describing selected items classified into different categories (page 19 validate form) (Examiner notes that this validate page would display a confirmation of all information inputted into the system);

h. imputing a user generated confirm message confirming said input of said classification data, said confirm order constituting a legal acceptance of a transaction for said trademark (page 19 validate form; page 51 Filing Date and Filing Receipt; page 56; page 106 what is TEAS). compiling/filtering and storing trademark, classification, price, and applicant data in a database (page 109 depository library) and (page 18, "Declaration"));

i. transmitting trademark data to a computer entity of an official trademark office as an electronic message (pages 1 e-TEAS);

j. said computer entity configured to generate a trademark application order form, receive instruction data (page 1 e-TEAS);

k. a search engine for searching and displaying data (page 1 SEARCH; pages 5-6);

l. at least one communication means (Internet), plurality of memory storage means (database for storing data) (page 5 Databases; page 109 Patent and Trademark Depository Library).

7. While TEAS is the USPTO electronic application system that can be used over the Internet, TEAS does not specifically disclose the structure of the system, wherein the system comprises a computer entity comprising a server computer entity and a client computer entity; said server transmitting data to a receiving client terminal, filtering/compiling data for storage in a database, and transmitting data to the receiving computer entity; at least one processor and at least one data processor; a web server configured to display and data and receive a webpage and other data; a user interface having a visual display device and a keyboard data entry means; displaying country data in which a trademark application may be filed; and automatically receiving an electronic filing receipt from an office trademark.

8. However, Lee discloses the structure of the system, wherein the system comprises a computer entity comprising a server computer entity and a client computer entity; said server transmitting data to a receiving client terminal, filtering/compiling data for storage in a database, and transmitting data to the receiving computer entity; at least one processor and at least one data processor; a web server configured to display and data and receive a webpage and other data; a user interface having a visual display device and a keyboard data entry means (Figures 1-3; col. 3, lines 42-46; col. 7, line 27 thru col. 8 line 11); and displaying country data in which a trademark application may be filed (col. 8, lines 19-37; Figure 3 jurisdiction).

9. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the electronic trademark application system of TEAS the structure and ability to display country data in which the applicant may be filed as

disclosed in Lee so that a party can file in multiple jurisdictions automatically in accordance with the jurisdiction requirements, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

10. TEAS does not disclose automatically receiving an electronic filing receipt from an office. However, Takano discloses an electronic filing receipt (col. 25, lines 45-50).

11. It would have been obvious to one of ordinary skill in the art to incorporate into the electronic trademark filing system of TEAS the electronic receipt taught in Takano so that one would have immediate proof that the document had been correctly received by the office to which it was being transmitted, thus having proof of filing and priority date, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

12. The Examiner notes the following as to applicant's claim limitations.

As to claims 1-8, the invention is directed to a method of processing transaction data relating to trademarks. Transaction data relating to trademarks can be almost any kind of data.

13. As written, applicant's claims merely display data, allow a user to input data at a user interface, generate and send/transmit a message/data and receive data.

The system comprises at least one processor, at least one communications means, memory/databases, a user interface, a search engine, wherein the system can send and receive data, display a web page. Moreover, generating a confirmation message confirming said data can be simply presenting the page back to the user entering data

to allow them to verify that all of the information is present and correct. This is done on a daily basis when information is being submitted over the Internet.

14. Moreover, most of the data being displayed, inputted, received, transmitted, etc. is non-functional descriptive data. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384-85,217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191,209 USPQ 1, 10 (1981).

15. However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry,, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004).

16. Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

17. The Examiner asserts that the data adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 21061V b I(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

18. Applicant's arguments filed 4/4/08 have been fully considered but they are not persuasive.

19. With regard to applicant's argument pertaining to the combination of TEAS and Lee. The test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art. In re Keller, 208 USPQ 871 (CCPA 1981). Here, applicant argues that TEAS does not teach multiple countries, Examiner respectfully disagrees. Further, applicant argues that, "the TEAS disclosure is concerned solely with US trade mark application for federal marks." One of ordinary skill and creativity in the art at the time of the invention would have

been able to use the TEAS disclosure for any jurisdiction which practices trade mark prosecution. Additionally regarding the user initiated confirmation which constitutes legal acceptance, Examiner respectfully disagrees with applicant. Upon clicking "Validate Form" on page 19 of TEAS, the user has upon penalty initiated performance constituting legal acceptance.

20. With regard to applicant's argument pertaining to non-functional descriptive material, Examiner respectfully disagrees. The confirmation generated by applicant is composed of printed matter which is not functionally related to the substrate, and no matter what the confirmation displays, the printed matter will not distinguish the invention from the prior art in terms of patentability.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. MEYERS whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Meyers/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689